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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,184	06/30/2006	Una Tucker	2204884-120US1	1165
23483	7590	07/27/2011	EXAMINER	
WILMERHALE/BOSTON 60 STATE STREET BOSTON, MA 02109				MATTER, KRISTEN CLARETTE
ART UNIT		PAPER NUMBER		
3771				
			NOTIFICATION DATE	DELIVERY MODE
			07/27/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/585,184	TUCKER, UNA	
	<b>Examiner</b>	<b>Art Unit</b>	
	KRISTEN MATTER	3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 June 2011.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 27 and 29 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 27 and 29 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date. _____ .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

This Action is in response to the amendment filed 6/27/2011. No claims have been amended, added, or cancelled. Thus, claims 27 and 29 are currently pending in the instant application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNair (US D233,703) in view of York (US 6,241,696) and Ferrier (US 2,806,470).**

Regarding claim 27, McNair discloses a hand-held self-contained massaging device for body massage, the device comprising: a lower portion forming a hand grip (i.e., the top portion seen in Figure 3) that bottom part of the hand grip being convex (see Figure 3); an upper portion forming a unitary arched dome structure (i.e., the bottom part seen in Figure 3) connected to the upper surface of the hand grip, wherein the arched dome member is gradually arched yet sufficiently flattened in nature so as to permit maximum contact with the body receiving the massage from the device (see Figures 2 and 3); and rounded side portions (see Figures 2 and 3) located at each end of the arched dome member; wherein the overall shape of the massaging device is of generally isosceles trapezoid shape (see Figure 3).

From the figures of McNair it appears as though the arched dome member is slightly longer than the hand grip (i.e., the slot where fingers are inserted). However, to the extent that the length is unclear and not verbally discussed in McNair, examiner cites York as teaching a similar hand-held massager that has a lower portion hand grip (3) and an upper portion arched dome member (1a), the arched dome member having a longer length than the hand grip (see Figure 2) and having a generally isosceles trapezoid shape overall. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the dimensions of McNair to have an arched dome member that is longer than the hand grip as taught by York in order to provide a larger massage surface area. Such a modification would appear to involve a mere change in dimension that does not patentably distinguish an invention over the prior art.

McNair lacks finger rings (i.e., McNair discloses a single slot for fingers). However, finger rings are well known in the art for allowing a user to grasp a manual massaging instrument as demonstrated by Ferrier (see Figure 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the finger slot of McNair with finger rings as taught by Ferrier in order to provide a better gripping area that would also help more with lateral pressure. Such a modification appears to involve the mere substitution of one well known finger grip means for another to produce predictable results that do not patentably distinguish an invention over the prior art and would have been obvious to try from three possible ways of allowing a user to get their fingers in the grip (i.e., one large slot as seen in McNair, notches as seen in York, or rings as seen in Ferrier).

The modified device is also silent as to the number of finger rings being four. However, York shows four finger notches because in such massager grips (i.e., those having slots for gripping) it is well known to insert the four fingers while having the thumb lie on the outside of the device (see Figure 7 of York). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to have four finger rings in the modified McNair device (in place of the four finger “notches”) in order to allow the four digits of a hand to be placed in the grip with the thumb on the outside as is common practice and well known in the art. There is nothing structurally in McNair preventing such a modification and McNair would perform equally well with four finger rings. Motivation for using finger rings can also come from the possibility that finger rings will allow even more force to be applied with the massager or better control particularly when moving the device laterally, for example.

**Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNair (US D233,703) in view of York (US 6,241,696), Ferrier (US 2,806,470), and Back (US D408,543).**

Regarding claim 29, McNair discloses a hand-held self-contained massaging device for body massage, the device comprising: a lower portion forming a hand grip (i.e., the top portion seen in Figure 3); an upper portion forming a unitary arched dome structure (i.e., the bottom part seen in Figure 3) connected to the upper surface of the hand grip, wherein the arched dome member is gradually arched yet sufficiently flattened in nature so as to permit maximum contact with the body receiving the massage from the device (see Figures 2 and 3); and rounded side portions (see Figures 2 and 3) located at each end of the arched dome member; wherein the overall shape of the massaging device is of generally isosceles trapezoid shape (see Figure 3).

From the figures of McNair it appears as though the arched dome member is slightly longer than the hand grip (i.e., the slot where fingers are inserted). However, to the extent that the length is unclear and not verbally discussed in McNair, examiner cites York as teaching a similar hand-held massager that has a lower portion hand grip (3) and an upper portion arched dome member (1a), the arched dome member having a longer length than the hand grip (see Figure 2) and having a generally isosceles trapezoid shape overall. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the dimensions of McNair to have an arched dome member that is longer than the hand grip as taught by York in order to provide a larger massage surface area. Such a modification would appear to involve a mere change in dimension that does not patentably distinguish an invention over the prior art.

McNair lacks finger rings (i.e., McNair discloses a single slot for fingers). However, finger rings are well known in the art for allowing a user to grasp a manual massaging instrument as demonstrated by Ferrier (see Figure 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the finger slot of McNair with finger rings as taught by Ferrier in order to provide a better gripping area that would also help more with lateral pressure. Such a modification appears to involve the mere substitution of one well known finger grip means for another to produce predictable results that do not patentably distinguish an invention over the prior art and would have been obvious to try from three possible ways of allowing a user to get their fingers in the grip (i.e., one large slot as seen in McNair, notches as seen in York, or rings as seen in Ferrier).

The modified device is also silent as to the number of finger rings being four. However, York shows four finger notches because in such massager grips (i.e., those having slots for gripping) it is well known to insert the four fingers while having the thumb lie on the outside of the device (see Figure 7 of York). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to have four finger rings in the modified McNair device (in place of the four finger “notches”) in order to allow the four digits of a hand to be placed in the grip with the thumb on the outside as is common practice and well known in the art. There is nothing structurally in McNair preventing such a modification and McNair would perform equally well with four finger rings. Motivation for using finger rings can also come from the possibility that finger rings will allow even more force to be applied with the massager or better control particularly when moving the device laterally, for example.

The bottom part of the hand grip of McNair is convex and thus McNair also lacks a concave bottom part. However, Back discloses a hand-held massager with a hand grip having a concave bottom part (see Figure 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the bottom part of McNair’s hand grip concave as taught by Back in order to increase comfort for a user pushing on the grip, for example.

### ***Response to Arguments***

Applicant's arguments filed 6/27/2011 have been fully considered but they are not persuasive.

In response to applicant's argument that McNair is rounded and thus does not function to provide "maximum contact with the body," examiner respectfully notes that the terms "gradually" arched yet "sufficiently" flattened...to permit "maximum" contact with the body are relative terms without a clear definition in the specification. There appears to be no way to measure what counts as "gradually arched yet sufficiently flattened" to read on the instant claims and it is not apparent what the "maximum" contact is compared against because a single dimension/shape of the dome member would provide various contact with the body depending on how hard the device was pushed (i.e., if pushed hard into a large fatty tissue area the dome member would "dig in" and be completely covered with body tissue but if pressed lightly or against a smaller or firmer area not as much of the dome member would touch body tissue, for example). Also, the amount of "slip" that happens when used for various types of massages would depend on material properties and frictional coefficients, not just the shape of the dome member. To elaborate further as discussed in the previous action, McNair teaches the structure of the instant invention as claimed. The limitation of the dome being arched yet sufficiently flattened is a relative term that does not have a set geometry. As seen in Figures 2-3 of McNair, the dome member has a large enough diameter (Figure 2) and ovoid shape (Figure 3) that the arch is somewhat flattened in a way that would provide "maximum contact" with the body and not point massage for example. Comparing with Figure 5 of the instant application, clearly there are areas on the instant invention that do not contact the dome member in the same manner as the McNair reference, and "maximum contact" is possible with both devices as designed. Therefore, it is the examiner's position that McNair is in fact gradually arched yet sufficiently flattened (see Figures 2 and 3) to allow maximum contact also depending on factors such as frictional

coefficients, body location being used and firmness of applied pressure in the same manner as the instant invention. Furthermore, regardless of intended use, as long as the prior art is fully capable of performing the intended function of the instant invention, which McNair is, then the device reads on the instant claims.

Applicant's arguments specifically regarding effleurage or perissage massage are also moot because these limitations are not found in the instant claims. However, as noted above, the modified McNair device is fully capable of performing these types of massages if the user chose to move the device in such a manner.

In response to applicant's argument that there is no reason to combine McNair and York, examiner respectfully maintains that both devices are hand-manipulated massagers and that one of ordinary skill in the art would look to all types of hand manipulated massagers when designing a new one. York is cited merely to show a similar well known general shape. The fact that McNair includes an electrical component is not dispositive when determining if there is reason to combine the references nor is the electrical component affected by a slight change in shape. York teaches a similar hand held massager that has a body similarly shaped to that instantly claimed and taught by McNair. Motivation to combine the main body portion of York with McNair can simply be to have a more comfortable grip, a more compact design to save space, and an even larger surface area for massage. There is nothing structurally in McNair preventing a change in shape and it appears as though McNair would work equally well with such a modification. The proposed modification is a mere change in shape without a change in function that does not patentably distinguish an invention over the prior art. Likewise, the fact that York includes rollers is not dispositive when determining if there is motivation to combine the

references because only the large dome member is being modified. The entire dome member is not covered by rollers in York, and examiner is merely suggesting that it would have been obvious to increase the length of the dome member as compared to the gripping area (if necessary to read on the claim language, which examiner does not concede) or to even further flatten the dome member as taught by York (again if necessary to read on the claim language, which examiner does not concede) to provide an larger massaging contact area, for example. Mere changes in dimension do not patentably distinguish an invention over the prior art.

In response to applicant's arguments involving Ferrier, examiner again notes that Ferrier is directed to a hand-manipulated massager and thus one of ordinary skill in the art could be expected to look to all sorts of hand-manipulated massagers when designing another one. Ferrier shows individual finger rings for providing a good grip on the device. A good grip is also a desired feature when using other hand-manipulated massagers and as such, examiner respectfully maintains that replacing the finger slot with four notches in the modified McNair device with four finger rings would have been an obvious design consideration to one of ordinary skill in the art as use of one well known gripping means for another in a well known device and/or obvious to try from a finite number of possible gripping means in the McNair device.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392,

170 USPQ 209 (CCPA 1971). Here, as discussed above, there is motivation to combine McNair and York in order to provide an even larger massage surface and there is motivation to combine Ferrier to provide a more secure grip as is well known in the art. Neither of these motivations requires examination of the instant specification for a conclusion of obviousness.

In response to applicant's arguments regarding Back, examiner respectfully disagrees that the "pistol grip" of Back cannot be considered concave. As seen in Figure 1, the top of the handle portion clearly has a concave component as opposed to a convex component. Again, Back is directed to another hand-manipulated massager and as such one of ordinary skill in the art could be expected to look to it when designing another hand-manipulated massager. Such a grip in the McNair device might provide more comfort for a user by more closely matching the contours of the hand changing the shape of the top of McNair's grip to that seen in Back involves the mere substitution of one well known gripping means for another in a well known device to yield predictable results that do not patentably distinguish an invention over the prior art. Furthermore, there is nothing structurally in McNair limiting the use of any well known gripping means in the device and it appears as though the device would work equally well with any well known gripping means.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN C. MATTER whose telephone number is (571)272-5270. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kristen C. Matter/  
Examiner, Art Unit 3771